

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUHA RAPELI

Appeal No. 2001-1530
Application No. 08/981,676

ON BRIEF

Before FLEMING, DIXON, and GROSS, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 3-6, 9-12, 14-16 and 18-23, which are all of the claims pending in this application.

We REVERSE.

Appellant's invention relates to a keyboard and key and telephone apparatus with such a keyboard. An understanding of the invention can be derived from a reading of exemplary claim 12, which is reproduced below.

12. A key for inputting characters said key having a face adapted to be engaged for actuation of said key, said key being arranged to correlate to a character in response to pressing once on said face of said key, said key being arranged to move when pressed in a direction generally normal to said face, said key having a main contact pad which is always activated when said key is pressed in said direction and at least one edge contact pad which is activated, in addition to the main contact pad, when said key is pressed in said direction at a point of said edge contact pad or close to said point, wherein an activation by said key of predetermined contact pads corresponds to an inputting of a predetermined character, and wherein said main contact pad and said at least one edge contact pad are separate and spaced from one another.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Strauch et al. (Strauch)	5,861,823	Jan. 19, 1999
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Claims 3-5, 10-12, 14-16 and 18-23 stand rejected under 35 U.S.C. § 102 as being anticipated by Strauch. Claims 6 and 9 stand rejected under U.S.C. § 103 as being unpatentable over Strauch.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's

answer (Paper No. 25, mailed Jan. 23, 2001) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 24, filed Nov. 8, 2000) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

35 USC § 102

Since appellant has indicated that all the independent claims 1 and 12 fall together in one group, we will select independent claim 1 and address appellant's argument with respect to this claim. Since appellant has indicated that all the dependent claims stand or fall together in one group, we will select dependent claim 5 and address appellant's argument with respect to this claim. (See brief at page 3.)

"Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention." **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. **See In re Thorpe**, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); **In re King**, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellant's burden before the PTO is to prove that the applied prior art reference does not perform the functions defined in the claims. Compare **In re Best**, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). The examiner maintains that Strauch teaches a "main contact pad and said at least one edge contact pad are separate and spaced from one another" as recited in independent claim 12. We disagree with the examiner. The examiner maintains that "a keyboard key is seen to comprise all the parts that form the mechanical and electrical switching parts." (See examiner answer at page 4.) We disagree with the examiner's expansive definition of the "key." We find that the language of claim 12 requires the "key being arranged to move" and "said key having a main contact pad . . . and at least one edge contact pad." Clearly, these pads are located on the moveable key. Therefore, the examiner's reliance (answer at page 5) on the contacts of Figure 6 is not appropriate since these

contacts are a pattern of parallel contact lines located on the circuit board and not on the key. While we agree with the examiner that the teachings of Strauch are very close to the claimed invention, we do not find that Strauch teaches the main and edge contacts on the key as recited in independent claims 10, 11 and 12. Therefore, we will not sustain the rejection of independent claims 10-12 and their dependent claims 3-5, 14-16, and 18-23.

35 USC § 103

To reject claims in an application under section 103, an examiner must show an unrebutted ***prima facie*** case of obviousness. **See *In re Deuel***, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper ***prima facie*** case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See *In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of ***prima facie*** obviousness or by rebutting the ***prima facie*** case with evidence of secondary indicia of nonobviousness.

In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Here, we disagree with the examiner's rejection and find that appellant has shown error in the rejection of dependent claims 6 and 9 since the examiner has not remedied the noted deficiency in Strauch nor has the examiner provided a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art to have modified Strauch to have the main and edge contacts on the key. Therefore, we find that appellant has

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overcome the rejection by showing insufficient evidence of a ***prima facie*** case of obviousness, and we will not sustain the rejection of dependent claims 6 and 9.

CONCLUSION

To summarize, the decision of the examiner to reject claims 3-6, 9-12, 14-16 and 18-23 under 35 U.S.C. §§ 102 and 103 is reversed.

REVERSED

MICHAEL R. FLEMING)

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Application No. 08/981,676

Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

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